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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92063457
Party	Defendant Apple Inc.
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Date	05/13/2016
Attachments	Sherlock Systems v. Apple_ Apple_s Answer and Affirmative De-fenses.pdf(35490 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 2,336,753

Registered: March 28, 2000

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SHERLOCK SYSTEMS LLC,	:	
	:	Opposition No. 92063457
Petitioner,	:	
	:	ANSWER AND DEFENSES TO
v.	:	PETITION FOR CANCELLATION
	:	
APPLE INC.,	:	
	:	
Registrant.	:	
-----X		

APPLE INC. (“Registrant”), a California corporation with a principal place of business at 1 Infinite Loop, Cupertino, California 95014, answers the Petition for Cancellation filed by Sherlock Systems LLC (“Petitioner”) as follows:

Registrant admits that it owns Registration No. 2,336,753 for the mark SHERLOCK covering the goods recited in the registration. Registrant admits that Petitioner has claimed the cited address as its principal place of business, but has insufficient information to confirm or deny the truth of these allegations.

1. Registrant admits the allegations in the first numbered paragraph, namely that Registrant’s predecessor Apple Computer, Inc. filed a trademark application, Application Serial No. 75/515,549, on an intent-to-use basis pursuant to Section 1(b) of the Lanham Act, to register the trademark SHERLOCK and that Registrant submitted a statement of use to the USPTO on November 10, 1999.

2. Registrant admits the allegations in the second numbered paragraph, namely that on March 28, 2000, the USPTO issued Registration No. 2,336,753 for the

SHERLOCK mark.

3. To the extent the reference to “the trademark” is intended to reference Registration No. 2,336,753 for the SHERLOCK mark, Registrant admits the allegations in the third numbered paragraph.

4. Registrant admits that on October 26, 2007, Registrant released Mac OS Leopard for its MAC computers.

5. Registrant admits that the SHERLOCK software application for which Apple uses the SHERLOCK mark that is the subject of Reg. No. 2,336,753 is a file and web search tool. Registrant further admits that its Mac OS X Leopard software did not include the SHERLOCK software application. Registrant denies the remaining allegations in the fifth numbered paragraph and denies that the exhibits support Petitioner’s allegations, as Registrant cannot confirm the authenticity of the documents in the exhibits.

6. Registrant admits that it produced and distributed its Mac OS X Tiger software and subsequently produced and distributed its Mac OS X Leopard software. Registrant admits that its Mac OS X Leopard software featured the SPOTLIGHT software application and did not include the SHERLOCK software application. Registrant denies the remaining allegations in the sixth numbered paragraph and denies that the exhibit cited supports Petitioner’s allegations, as Registrant cannot confirm the authenticity of the document in the exhibit.

7. Registrant denies the allegations in Petitioner’s seventh numbered paragraph.

8. Registrant denies the factual allegations in Petitioner's eighth numbered paragraph and denies the statements in the paragraph, as they are legal arguments rather than factual allegations.

9. Registrant denies the statements in Petitioner's ninth numbered paragraph, as the statements are legal arguments rather than factual allegations.

10. Registrant admits that its Mac OS X Leopard and its subsequently released operating system software for MAC computers do not include the SHERLOCK software application. Registrant further admits that the Mac OS X Leopard software includes the SPOTLIGHT software application. Registrant also admits that the SPOTLIGHT and DASHBOARD software applications are software applications that perform similar functions to the SHERLOCK software application. Registrant denies the remaining allegations in the tenth numbered paragraph.

11. Registrant denies the allegations in Petitioner's eleventh numbered paragraph.

12. Registrant denies the statements in Petitioner's twelfth numbered paragraph, as the statements are legal arguments rather than factual allegations.

13. Registrant admits that it has submitted two affidavits pursuant to Section 8 of the Lanham Act in support of Reg. No. 2,336,753. Registrant denies that the documents included in the referenced exhibit are copies of the affidavits filed by Registrant.

14. Registrant admits that the first page of Exhibit A appears to be a reproduction of the specimen, not the affidavit, submitted by Registrant to the USPTO on

March 22, 2010. Registrant further admits that the Mac OS 9.2.2. software depicted in the image on the first page of Exhibit A includes the SHERLOCK software application. Registrant denies the remaining allegations in Petitioner's fourteenth numbered paragraph.

15. Registrant admits that it ceased development of the Mac OS 9 software in or before 2003. Registrant denies the remaining allegations in Petitioner's fifteenth numbered paragraph and denies that the exhibit cited support Petitioner's allegations, as Registrant cannot confirm the authenticity of the document in the exhibit.

16. Registrant denies the allegation in the sixteenth numbered paragraph, but admits that the exhibit reflects a copyright notice date of 1983-2001.

17. Registrant denies the allegation in the seventeenth numbered paragraph.

18. Registrant denies the factual allegations in the eighteenth numbered paragraph, and Registrant denies the statements in the paragraph, as they are legal arguments rather than factual allegations.

19. Registrant denies the allegation in the nineteenth numbered paragraph.

20. Registrant denies the factual allegations in the twentieth numbered paragraph, and Registrant denies the statements in the paragraph, as they are legal arguments rather than factual allegations.

21. Registrant denies the allegations in the twenty-first numbered paragraph.

FIRST AFFIRMATIVE DEFENSE

Petitioner's Petition for Cancellation fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Petitioner lacks standing to assert the claims in its Petition for Cancellation.

THIRD AFFIRMATIVE DEFENSE

Petitioner's claims in its Petition for Cancellation are barred by the doctrines of laches, estoppel, and waiver.

FOURTH AFFIRMATIVE DEFENSE

Registrant reserves the right to amend its answer to add additional or other affirmative defenses as may become necessary after a reasonable opportunity for appropriate discovery.

WHEREFORE, Registrant respectfully requests that the Trademark Trial and Appeal Board dismiss the Petition for Cancellation with prejudice and deny Petitioner's request for cancellation of Registration No. 2,336,753.

Dated: May 13, 2016

Respectfully submitted,

**KILPATRICK TOWNSEND &
STOCKTON LLP**

By: /s/ Joseph Petersen

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CERTIFICATION OF SERVICE

This is to certify that a copy of the foregoing **ANSWER AND DEFENSES TO PETITION FOR CANCELLATION** has been served on Petitioner by depositing said copy with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to:

Jonathan Morton
246 WEST BROADWAY 4TH FLOOR
NEW YORK, NY 10013

Dated: May 13, 2016

/s/ Alberto Garcia
Alberto Garcia